#7 2-27-03 DW

Pat nt

Case No.: 56763US002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor:	MCGURRAN, DANIEL J.		
Application No.:	09/872532	Group Art Unit:	1773
Filed:	June 1, 2001	Examiner:	Ahmed, Sheeba
Title:	COLOR-STABLE PIGMENTED POLYMERIC FILMS HAVING DYES FOR COLOR ADJUSTMENT		

RESPONSE UNDER 37 CFR § 1.111

Commissioner for Patents
Washington, DC 20231

CERTIFICATE OF FACSIMILE TRANSMISSION
I hereby certify that this correspondence is being sent by facsimile transmission to Group Art Unit 1773, attn: Examiner Sheeba Ahmed, at Fax No. 703-305-5408:

Feb 11, 2003 (Date) Stephen C. Jensen (Signed by:)

Dear Sir:

Introduction

This application was filed June 1, 2001 with 21 claims. In an Office Action dated 9/11/2002, all of these claims were rejected. The Office Action set a shortened statutory period of 3 months for reply, which period ended Dec. 11, 2002.

Petition for 2-Month Extension Under Rule 136(a)

Applicants respectfully petition the Assistant Commissioner for Patents for an extension of time under the provisions of 37 CFR § 1.136(a). Please charge the following fee to Deposit Account No. 13-3723:

37 CFR § 1.17(a)(2) - Extension within second month.

FAX RECEIVED
FEB 12 2003
TC 1700

02/05/2003 KKEBEDE 00000020 133723 09872532
01 FC:1252 410.00 OP

Remarks

Reconsideration and continued examination of the present application is respectfully requested in view of the remarks that follow. No amendments to the claims have been made.

The Office Action rejected claims 1-20 as obvious (35 U.S.C. § 103(a)) over U.S. Patent 4,603,073 (Renalls et al.) in view of U.S. Patent 6,111,696 (Allen et al.). The Office Action

contends, *inter alia*, that Renalls et al. disclose a single or multilayer polyester film corresponding to the optical body of the claimed invention, that it would have been obvious to add a dye to the film, and that the limitations relating to a*, b*, transmission of light, and haze values can be optimized by one of ordinary skill. This rejection, however, cannot be sustained.

It is axiomatic that to establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest each and every limitation of the rejected claim(s). See M.P.E.P. § 2142. Furthermore, each prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In the present application, independent claims 1 and 14 recite pigmented optical bodies exhibiting a transmission of light within a wavelength band of interest within the visible spectrum of from 5% to 90%. In contrast, Renalls et al. is directed specifically to *opaque* polyester films useful as a film base for magnetic recording media. Regarding the desired opacity, Renalls et al. teach "no more than 0.5%" (see col. 1 lines 17-18, Example 1 and 2 transmission data in the table at column 7, and claim 5) and "only about ¼%" (see col. 4 lines 1-2) at a wavelength of 940 nm. Such opacity values are purposeful, for optical sensing of an index hole in diskette recorders. (See col. 1 lines 15-16.) Although the Examiner is correct to point out that the percent weight of particulate called out in Renalls et al. (0.1 to 3%) overlaps somewhat with the percent weight recited in pending independent claim 1 (between 0.01 and 1%), this parameter does not by itself, nor even in combination with only a particulate particle size range, dictate the percent transmission of the optical body. This is of course consistent with the fact that pending claim 1, for example, not only recites (1) a range for the weight percent of the particulate pigment, and (2) an upper limit on the mean diameter of the particulate pigment, but also (3) a range of the percent transmission of the optical body. Because Renalls et al. not only fail to teach or suggest a pigmented optical body with the specified percent transmission, but teach away from such a body, the obviousness rejection of claims 1-20 cannot be sustained.

Applicants also wish to point out that although Allen et al. teach that the films and optical devices *of that invention* may be treated with inks, dyes, or pigments to alter their appearance or to customize them for specific applications (see column 25 line 30 ff.), the reference provides no rationale, suggestion, or hint to motivate one of ordinary skill to add a dye to the already opaque pigmented films of Renalls et al., much less to add a dye "to adjust the transmitted color of the

optical body to a substantially neutral gray" (claim 1), or "in an amount effective to adjust the color of the optical body by nor more than 15 units of a* and by no more than 15 units of b*" (claim 14). For this additional reason the rejection of claims 1-20 should be withdrawn.

The Office Action also rejected dependent claim 21 as obvious (35 U.S.C. § 103(a)) over U.S. Patent 4,603,073 (Renalls et al.) in view of U.S. Patent 6,111,696 (Allen et al.) and U.S. Patent 6,242,081 (Endo). In response, Applicants note that claim 21 depends in the alternative from claim 1 or claim 14, and is submitted to be allowable at least for the reasons set forth above in connection with those claims.

Conclusion

For the foregoing reasons, the present application is submitted to be in condition for allowance, the early indication of which is earnestly solicited. Reconsideration of the application is requested.

Beyond the fees authorized above for the 2-month extension of time under Rule 136, no additional fee is believed to be due. If this belief is in error, please charge any additional required fee to Deposit Account No. 13-3723.

Respectfully submitted,

Feb. 11, 2003
Date

By: Stephen C. Jensen
Stephen C. Jensen, Reg. No.: 35,207
Telephone No.: 651-736-3369

Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427
Facsimile No.: 651-736-3833